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10/638,179

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Ulrich Birnbaum

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DAVID TOREN, ESQ.  
ABELMAN FRAYNE & SCHWAB  
666 THIRD AVENUE  
NEW YORK, NY 10017-5621

EXAMINER

MACARTHUR, VICTOR L

ART UNIT

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3679

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/638,179	<b>Applicant(s)</b> BIRNBAUM ET AL.	
	<b>Examiner</b> VICTOR MACARTHUR	<b>Art Unit</b> 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2,4-8,13,15 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) 4-8,20 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,13,15,21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 9, 16-18 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 3/14/2005.

Newly submitted claim 23 is directed to an invention that is independent or distinct from the invention originally claimed for the following reason:

- The combination of claim 23 does not require the particulars (e.g., “corrugation” [present version] or “bead” [original version]) of the originally presented subcombination of claim 22; and the originally presented subcombination of claim 22 has utility by itself (connecting element not in an assembly) in accordance with MPEP § 806.05(c).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 23 is withdrawn from consideration as being directed to a non-elected invention. Claims 4-8 and 20 have been amended to depend from claim 23 and are thus similarly withdrawn from consideration. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Preamble***

The preamble of claim 22 merely recites the use or purpose of the claimed invention such that the body of the claim following the preamble is a self-contained description of the structure

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and does not depend on the preamble for completeness. Accordingly, the examiner has determined that "connecting element" is not limited by "an assembly system comprising... system supports". Rather, the "connecting element" is merely intended to be used "for an assembly system comprising... system supports". The examiner has considered the claims **without** combination. See MPEP 2111.02 and *Kropa v. Robie*, 88 USPQ at 480-481; *Rowe*, 42 USPQ2d at 1553; and *IMS Technology Inc. v. Haas Automation Inc.*, 54 USPQ2d 1129, 1137 (Fed.Cir.2000). Claim 15 is primarily drawn to a support recited in claim 1 as only being intended to be used with the connecting element. Accordingly this claim is taken as merely elaborating on an intended use.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims **with reference characters described in the specification**. Therefore, the "spaced elongated sides" (line 5 of claim 22), "the elongated direction" (line 8 of claim 22), the "corrugation" (line 17 of claim 22), the "surface" (line 18 of claim 22), the "first wall" (line 19 of claim 22), the "first and second side walls" (line 20 of claim 22), and the "surface" (line 21 of claim 22) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing

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should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Every element recited in the claims must be described in the written description **with reference characters** regarding the drawings; or those features must be deleted from the claims. Therefore, the “spaced elongated sides” (line 5 of claim 22), “the elongated direction” (line 8 of claim 22), the “corrugation” (line 17 of claim 22), the “surface” (line 18 of claim 22), the “first wall” (line 19 of claim 22), the “first and second side walls” (line 20 of claim 22), and the “surface” (line 21 of claim 22) must be described with reference characters or canceled from the claim(s). No new matter should be entered.

### ***Claim Objections***

Claim 22 is objected to because of the following informalities:

- “members 2;12;32;3;13;33)” (line 6 of claim 22) should be replaced with  
--members (2;12;32;3;13;33)--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22, 2, 13, 15 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are generally narrative and indefinite, failing to conform to current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. Take for instance the following examples:

- The term “tooth-like” (recited throughout the claims) is unclear. The addition of the word “like” to an otherwise definite expression extends the scope of the expression so as to render it indefinite. It is unclear what the word “like” is intended to convey. See MPEP § 2173.05(b).
- It is unclear if “a surface from which said corrugation extends” (line 21 of claim 22) refers to “a surface” (lines 17-18 of claim 22), which is also disclosed as having a corrugation extending therefrom; or to an additional surface.

- It is unclear how the corrugation of applicant's elected species has a first wall "generally parallel to and spaced outwardly from the surface containing the elongated opening". As shown in elected figures 3, 3a, 4 and 5, the corrugation has a wall that is roughly 45 degrees (i.e., it is a triangle) not parallel.

For the reasons mentioned above a great deal of confusion and uncertainty exists as to the proper interpretation of the claim limitations. In accordance with the MPEP § 2173.06, rejection under 35 U.S.C. 102 or 35 U.S.C. 103 follows based on the examiner's best understanding of the claim scope. The applicant is strongly urged to amend the entirety of the claims (not only the examples listed above) to conform to current U.S. practice.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2, 13, 15, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Seibold (U.S. Patent 5,435,107).

Claim 22. Seibold discloses (figs.2 and 4) a connecting element, the connecting element comprising an elongated first member (3) and at least one elongated second member (1) with spaced elongated sides and with at least one of said first and second members having at least one elongated opening (10) spaced between and inwardly of said elongated sides thereof and extending in the elongated direction thereof and with at least a plurality of notches (18) formed

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by a continuous toothing and extending transversely of the length of said elongated opening; said connecting element has at least one corrugation (top corrugation of 3) formed therein extending outwardly from a surface of at least one of said first member or second member containing said elongated opening, said corrugation having a first wall generally parallel (in as much as applicant's invention is, see 112 2<sup>nd</sup> rejection above) to and spaced outwardly from the surface containing the elongated opening, and first and second side walls extending from said first wall to a surface from which said corrugation extends, said first side wall facing said opening and having tooth-like notches therein complementary to tooth-like notches in one of said supports to which said connecting element is to be secured. Furthermore note the following:

- Since the prior art product structure is substantially identical to that claimed by applicant, as detailed above, it is presumed that the Seibold connecting element is structurally capable of performing the functional intended use of being used for an assembly system comprising a plurality of system supports having openings arranged in a defined spacing on at least one of a plurality of outer walls of the system supports, in accordance with MPEP 2112.01(I).
- Since the prior art product structure is substantially identical to that claimed by applicant, it is presumed that the Seibold elongated opening is structurally capable of performing the functional intended use limitation of being used for securing a connecting element to a system support or to a base surface by a fastening element, passed through the at least one elongated opening, and engageable with complementary notches of a fastening element, in accordance with MPEP 2112.01(I).



Claim 2. Seibold discloses that the second member is arranged essentially perpendicular to said first member.

Claim 13. Seibold discloses that a surface zone (surface zone having the notches) surrounding at least one said elongated opening has said notches.

Claim 15. Seibold discloses that the first and second members of the connector have outer contours such that the Seibold connecting element is structurally capable of performing the intended use of being for an assembly system comprising a plurality of system supports with outer complementary contours so that said supports to be connected thereto.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Seibold (U.S. Patent 5,435,107).

Claim 21. A pitch of 2.5 mm is within the scope of the disclosure of the Seibold teeth. However, Seibold does not expressly state the exact tooth pitch. Seibold states that the teeth are for prevention of sliding between components (col.3, ll.52-57). One of ordinary skill in the art would recognize that a tooth pitch of 2.5 mm is capable of preventing sliding between components. It has generally been recognized that the optimization of proportions in a prior art device is a design consideration within the skill of the art. In re Reese, 290 F.2d 839, 129 USPQ

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402 (CCPA 1961). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to optimize the proportion of the Seibold tooth pitch to be 2.5 mm, in accordance with the scope of the Seibold disclosure, as such practice is a design consideration within the skill of the art.

### ***Response to Arguments***

Applicant's arguments with regard to the claim rejections have been fully considered but they are not persuasive.

All of applicant's claimed limitations are met by the prior art within the broadest reasonable interpretation of the claim language. Subject matter that is not recited in the claims cannot be relied upon to persuasively argue for allowability. Claimed limitations cannot be persuasively argued to have a scope narrower than that, which is reasonably most broad. In a product claim, intended use, labeling and functional language cannot overcome the prior art wherein the prior art discloses structure fully capable of performing such uses and functionality. Capability need not be expressly stated in the prior art wherein it is inherent to the structure disclosed but is instead presumed to be inherent in accordance with MPEP 2112.01(I). Motivation to combine the references comes from knowledge generally available to one of ordinary skill in the art and the references themselves. Lastly, the Supreme Court has consistently held that where all of the pieces of the invention are known in the prior art it is not patentable to combine known pieces, even to produce beneficial results, unless those results are unexpected and unpredictable. That is to say that if cogent reasoning, based in no part upon hindsight, demonstrates predictability of the new result, a patent will not issue. See In Re

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Hotchkiss v. Greenwood, 52 U.S. 248, which stated that even beneficial results of being "made firm and strong, and more durable" do not render an invention patentable over the prior art if those results are predictable; see also In re KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007), which states "[T]he results of ordinary innovation are not the subject of exclusive rights under the patent laws. Were it otherwise patents might stifle, rather than promote, the progress of useful arts. See U.S. Const., Art. I, section 8, cl.8."

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

July 3, 2008

/Victor MacArthur/  
Primary Examiner, Art Unit 3679